

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

APPEAL FROM ORDER No 280 of 1998

with

CIVIL APPLICATION NO 5735 OF 1998

For Approval and Signature:

Hon'ble MR.JUSTICE M.S.PARIKH

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1. Whether Reporters of Local Papers may be allowed to see the judgements?
2. To be referred to the Reporter or not?
3. Whether Their Lordships wish to see the fair copy of the judgement?
4. Whether this case involves a substantial question of law as to the interpretation of the Constitution of India, 1950 of any Order made thereunder?
5. Whether it is to be circulated to the Civil Judge?

CADILA HEALTHCARE LIMITED

Versus

CADILA PHARMACEUTICALS LIMITED

Appearance:

MR RAVI KADAM learned Counsel with MR RR SHAH for and
Mr HR Shah for the appellants.

MR Bharatbhai J. Shelat, learned Sr.Counsel with MR YJ
TRIVEDI and Mr.NN Prajapati for Respondent No. 1

CORAM : MR.JUSTICE M.S.PARIKH

Date of decision: 14/07/98

ORAL JUDGEMENT

The appellant who has been described as the plaintiff hereinafter has instituted Regular Civil Suit No. 7 of 1998 in the District Court, Vadodara against the respondents-original defendants for obtaining the

permanent injunction restraining the defendants manufacturing, advertising or selling any medicinal or pharmaceutical product bearing impugned mark FALCITAB or any other mark deceptively similar to the plaintiff's trade mark FALCIGO so as to pass off or enable others to pass off the Defendants' goods as and for the goods of the plaintiffs. In the said suit, the plaintiffs prayed for like ad-interim relief at Exh. 5 which came to be heard by the learned Extra Assistant Judge, Vadodara who by his impugned order dated 30th May, 1998, refused to grant interim relief. That is how the plaintiffs have been before this Court in this appeal from order.

2. This appeal came to be placed for admission and interim relief but since there had been appearance of the respondents on caveat, the matter has been argued extensively. In that view of the matter, I propose to dispose of this matter finally instead of deciding only interim relief.

FACTS IN BRIEF

It is not in dispute that the plaintiff and the defendant are carrying on their activities in pharmaceutical products respectively in the name and style of "CADILA HEALTH CARE LIMITED" and "CADILA PHARMACEUTICALS LIMITED" with the word "CADILA" being common first name. It has been the case of the plaintiffs that it developed the formulation of drug of Chinese origin styled as "Artesunate" extracted and synthesized from a plant for treatment of the aggravated form of Malaria commonly known as FALCIPHARUM. The plaintiff introduced the product both in tablet and injection form under the brand name of 'FALCIGO' which according to the plaintiff, has proved effective in the treatment of FALCIPHARUM MALARIA. Necessary drug permission was granted by the authorities on 7.10.1996. The plaintiff also lodged its application for registration of FALCIGO as its trade mark on 20.8.1996 and in or around October, 1996, the product was introduced in the market. It has been the case of the plaintiff that the product has been extensively marketed all over the country and it has acquired good reputation due to the quality and standard of the product and the sales promotion efforts of the Plaintiff Company. Its turn over during the last two years has exceeded Rs.386.96 lacs. As against this, the defendant recently introduced product under the brand name FALCITAB containing the drug 'Mefloquine'. According to the plaintiff, their product FALCIGO is very well known in the market and has been widely advertised and the defendant's mark FALCITAB is

identical and/or deceptively and/or confusingly similar to and is a word per se colorable imitation of the plaintiff's said trademark FALCIGO. According to the plaintiff, the defendant has passed off and/or further threatened to pass off and/or is facilitating others to pass off the product of the defendant as and for the well known goods of the plaintiff by using the mark FALCITAB. This has resulted in serious injury to the plaintiff's reputation; besides, on account of common word "CADILA" as a part of corporate names of both the Companies, the defendants' trade mark FALCITAB and the plaintiff's trade mark FALCIGO would create lot of confusion in the market about the respective products. The plaintiff has, therefore, sought for interim relief as above.

3. While denying the allegations as aforesaid, the defendant has asserted that the defendant has been well established and fast blowing Pharmaceutical Company. It is denied that the word 'FALCIGO' is a fanciful word or that the said word is a trademark as alleged. It is also denied that the product FALCIGO is continuously and extensively marketed as alleged. It is denied that the defendant's trade mark FALCITAB is identical and/or deceptively and/or confusingly similar to the plaintiff's mark FALCIGO. It is further denied that the trade mark FALCITAB is per se colorable imitation of the plaintiff's trade mark as alleged. It is denied that the defendant has passed off and/or threatened to pass off and/or is facilitating others to pass off the goods of the defendant as and for the goods of the plaintiff by using the word FALCITAB as alleged. It is submitted that the trade mark FALCITAB is not likely to cause confusion and deception in the course of trade and the plaintiff's reputation would not be seriously injured as alleged. It is submitted that after tremendous research work, it has invented "Mefloquine Hydrochloride" drug for the treatment of FALCIPHARUM MALARIA. It has been accorded the drug licence for the same on 3.7.1997. However, the tablet form of its product received accord on or around 10.4.1997 and the product under the brand name of FALCITAB has been in the market since then. It has been alleged that the plaintiff has chosen to initiate this action on account of some pending litigations between the parties with a view to harass the defendant. It is contended that 'FALCITAB' mark has been obtained by it as of right and its registration as trademark is pending before the authority under application dated 30th June, 1997 Both the marks are distinct and different in all respect. Both the marks are allowed to be sold and are supplied only to the hospitals, clinical institutions and nursing homes. Both are under a condition to print

caution note " FOR HOSPITALS' USE ONLY' and both are strictly prohibited regarding sale through retail outlet. There is no question of unwary consumers getting confused in purchasing the products.

4. The learned trial Judge, after hearing both the sides and after considering the decisions cited before him, came to the conclusion that there is no likelihood of confusion resulting from the use of the respective marks since they cannot be said to be similar either phonetically or visually or with respect to their respective prices (the price of FALCIGO is not to exceed Rs. 60 for a strip of four tablets whereas the price of FALCITAB is Rs. 230/- for a strip of six tablets/ten tablets).

SUBMISSIONS

5. I have heard the learned counsels appearing for both the sides.

6. Before the submissions made by the learned counsels are set out, it might be noted that this appeal deals with a discretionary order. It is a settled proposition of law that interference with such a discretionary order is permissible only if the order is shown to be arbitrary, perverse, capricious or in disregard of the legal principles.

In so far as the present case is concerned, Mr. Kadam, learned counsel appearing for the plaintiff has pressed into service the cause of unwary consumers by reading the caution note and the side effects which have been set out by the defendant in respect of its product FALCITAB. Further, he has submitted that if the defendant's product FALCITAB is allowed to be marketed under the mark FALCITAB, there is likelihood of same being passed off for the plaintiff's product namely FALCIGO having no side effects and the ultimate sufferer would be the unwary consumer. It is in this sense that he pressed into service the public interest aspect of the matter and tried to show before this Court that the trial Court has fallen into error of law to this extent. He has made a specific reference to the fact that both are "Cadilas" and this common word "Cadila" as part of their company's name might tend to cause confusion in the mind of unwary consumers. He has relied upon number of decisions which will hereinafter be referred to.

In reply, Mr. B. J. Shelat, learned counsel appearing for the respondent has made reference to the words used as marks by both the Companies and tried to

point out that there is no possibility of any confusion in the mind of unwary consumers. According to his submission, even the scheme of strips as well as the packings in the context of the words printed or the signs used in so far as both the products are concerned are quite different. He has submitted that appearance of both the marks is also dissimilar so that there is no chance worth the name for unwary consumers to be taken by surprise while buying the product. He has pointed out from the packings of both the products that the word "CADILA" is used in different types and class of letters so that even from that point of view also, there is no likelihood or confusion resulting from respective marks of both the products. In so far as the tablets are concerned, the plaintiff company has been using the strip of four tablets whereas the defendant company has been using the strip of six/ten tablets. In respect of the drugs, the plaintiff company has been using the 'artesunate' as a source of its drug while the source of drug of the defendant's product is "Mefloquine Hydrochloride". Therefore, both the sources are different and are discernible on the face of them. It has been submitted by the learned counsel for the respondent that the most important distinguishing feature is with regard to the display of caution note and the side effects by the defendant Company in respect of its product FALCITAB. That has been unnecessarily highlighted for canvassing the alleged public interest. According to his submission, the defendant's product is a medicine and not the product which per se would cause injury to human health. It is meant for arresting deadly disease known as FALCIPHARUM MALARIA. Under such circumstances, even on the question which has been sought to be raised by the learned counsel for the appellant, the order impugned herein needs no interference by this Court.

7. It is no doubt, true that the interest of unwary consumer and, therefore, interest of public is required to be taken into consideration while dealing with the grant of injunction. In this connection, reference has been made to the decisions of the Hon'ble Supreme Court in Corn Products v. Shangrila Food Products, AIR 1960 SC 142 and of this Court in Simatul Chemical Industries v. Cibatul Ind, 19 GLR 315 and in Appeal from Order No. 84 of 1973 between Macwell Engineering Works Ahmedabad versus Divya Industries, Rajkot decided on 18th November, 1974 (Coram: M. P. Thakkar, J. as His Lordship then was). It has been observed in the Macwell Engineering Works' case that it ought to be realised that it was not merely a case of protecting the right of the plaintiffs,

the Court was also concerned with protecting the unwary consumers. It was evident that having regard to the similarity in the names an innocent purchaser would have been misguided and would have taken the engines manufactured by the plaintiffs. It is no doubt true that His Lordship was concerned with the names "Macwell" and "Macweel" with regard to which it was observed that there was apparent confusion likely to be caused in the mind of innocent purchaser. Suffice it to say that in a given case where the marks are shown to be so similar as to cause confusion in the mind of unwary consumer, the Court is required to take care of such interest. Reference in this connection has also been made to a decision of the Bombay High Court in the matter of Nucron Pharmaceuticals Pvt. Ltd. and another vs. International Pharmaceuticals reported in IPLR 1994 Vol.19 (1-2)page 56. In that case, the plaintiffs were selling their antibiotic preparation under the mark SEPMAX for various types of infections since 1991 which had become well known. In December, 1992, the plaintiffs found that defendants were marketing their product under the trademark SELMAX for treatment of parkinsonism neurological disease. During the course of hearing, the defendants contested that their brand was distinguishable from plaintiffs' SEPMAX on account of differences in colour and manner of packing, whereas in the civil suit at Ahmedabad, their contention was that the plaintiffs' mark was deceptively similar to their SELMAX! In the back ground of the nature of two products, learned Single Judge of the Bombay High Court held that the defendants had no convincing explanation as to how they came to adopt the trademark SELMAX. He held that the defendants' contention that their drug was available only on doctor's prescription was not acceptable since it is well known that even in large cities, Schedule 'H' drugs are sold by chemists without the doctor's prescription and that the mark was deceptively similar to the plaintiff's mark and was likely to lead to serious consequences in view of the fact that while the plaintiffs' preparation was a broad based Antibiotic, the defendants' drug was used for a neurological disease i.e. Parkinsonism. and if drug is administered for the other drug. It is under such circumstances that the Bombay High Court was required to take care of the consumers' interest while dealing with the interim relief aspect. Reference has also been made to another judgment of the Bombay High Court in the matter of Astra-IDL Ltd. vs. TTK Pharma Ltd. in AIR 1992 Bombaay pg. 35. In the said matter, the marks under dispute were "BETALONG" & "BETALOC" used in connection with Pharmaceutical preparations. It has been observed by the Court that in the present day circumstances,

doctor's prescription factor has lost its importance since the reality of the situation cannot be ignored. In India, scheduled drugs which are to be sold under doctor's prescription are even sold without production of doctor's prescription and as such, reduces the weightage that can be given to this aspect of the matter while considering the question of deceptive similarity. The marks "Betalloc" and "Betalong" being visually, phonetically and structurally similar and so close to each other that it outweighs the weightage to be given to the factor that the goods are schedule 'H' drugs. It was observed that the medicines could also be available across the counter in the shops of various chemists and the test to be adopted is not only of the doctor giving prescription but was whether unwary customer who went to purchase the medicine could make mistake or not. Said concept was high lighted by the Delhi High Court in the matter of Ranbaxy Laboratories Ltd. v. Dua Pharmaceuticals Pvt.Ltd. reported in AIR 1989 Delhi 44, while dealing with the marks "CALMPOSE" and "CALMPROSE". The learned counsel has then made a reference to the decision of this Court in the matter of CIBA-GEIGY LTD.V. TORRENT LABORATORIES PVT.LTD. & ANOTHER reported in 1993(1) GLR 325. This he did with a view to explain the decision of the Hon'ble Supreme Court in Roche & Co. v. G. Hanners & Co. AIR 1970 SC 2062 where the apex Court held that the marks "Dropovit" and "Protovit" could not be said to be deceptively similar. He read before this Court the observations appearing in paragraph 11 of the citation which might be excerpted:

"11. Reliance was placed by Mr. Shah on the decision of the Supreme Court in Roche & Co. (supra) in support of his submission that there was no likelihood of any deception or confusion in the case of medicinal preparations because they were required to be sold by a licensed dealer and on medical prescription. The Supreme Court was considering the question as to whether the word "DROPOVIT" was deceptively similar to the word "PROTOVIT". It will be noticed from the decision that it does not rest simply on the ground that there was no likelihood of any deception or confusion in respect of medicinal preparations which were required to be sold under Doctor's prescription by a Chemist. The Supreme Court, in fact, compared both these words laying down the test for such comparison. Paragraph 12 of the judgment indicates the careful manner in which these words were compared by the Supreme Court. The Supreme Court traced the uncommon

element in these words and found that the common syllable 'VIT' in the two marks was both descriptive and common to the trade. It also made phonetic comparison and found that there was no reasonable probability of confusion between the words either from visual or phonetic point of view. If the Supreme Court intended to lay down the proposition of law that wherever the medicinal preparations are to be sold by a Chemist on Doctor's prescription, there was no likelihood of any deception or confusion, it would not have undertaken any exercise of comparing the words nor would it have laid down the test for comparison in the context of such medicinal preparations. The Supreme Court, in fact, held that the question of deceptive similarity must be decided on the cases of class of goods to which the two trademarks applied. The observations of the Supreme Court that, from the nature of the goods, it was likely that most of the customers would obtain a prescription from a Doctor and show it to the Chemist before they purchase and in such a case except in the event of hand writing of the Doctor being very bad or illegible, the chance of confusion is remote, cannot, therefore, be so construed as to lay down a proposition that there was no likelihood of any deception or confusion in respect of medicinal preparations required to be sold by a Chemist on Doctor's prescription. No such absolute proposition was at all intended by the Supreme Court since as observed above, the Supreme Court itself undertook the task of comparison of the impugned mark and the registered trademark to find out whether there was any probability of confusion. The deception or confusion in such cases would be of the public and not of an expert Doctor or a specialized chemist dealing in the medicinal preparations. One cannot ignore the fact that when a mark likely to deceive or cause confusion is to be used by a person, he will strive to find those who join him in his design and an obliging doctor and a conniving chemist will be the integral part of the design to practice deception and cause confusion. The question of likelihood of deception of those who help in practicing deception cannot really arise and it is the likelihood of the deception of their victims, i.e., the unwary purchaser that is material for the purpose of deciding whether the mark should be registered or not in view of the

provisions of section 11(a) of the Act. The real question is whether it is likely that the mark proposed is capable of being used for causing deception or confusion by those who are mindful of propagating it for their self-aggrandizement by using it for taking advantage of the reputation of the registered mark. If the mischief is potential, the registration ought to be refused."

No doubt, the aforesaid paragraph which has been canvassed in this case makes an excellent exposition of legal position in a given set of circumstances. The basic aspect which can even be noticed from the aforesaid paragraph is whether the two marks are so similar as to cause confusion in the mind of unwary consumers. Therefore, the exercise obviously is first to find out whether the marks are primarily and basically similar both phonetically as well as visually. If that is not so, there is no question of any confusion in the mind of unwary consumer. Therefore, there can be no debate on the question of propositions emerging from the above observations except that in case of medicinal preparations, the doctor's prescription aspect cannot be said to be wholly irrelevant as can be seen from what has been said by the Hon'ble Supreme Court in the case of Roche & Co. (supra).

In the above case, the question was with regard to the registration of a trade mark with the letters 'CEBA' as a part of the mark, The Court considered the fact that the use of the word "CEBA" in the mark could create confusion in the mind of public and could pass off as the trade mark of the earlier registered trade mark. Therefore, in the facts before the Court, while bearing in mind the proposition appearing in paragraph-11 quoted above, this court came to the conclusion that there was likelihood of deception being caused in the mind of public.

Then there is a reference to one more decision of this Court endorsing the aforesaid view. That is in the case of CADILA PHARMACEUTICAL LTD. VS. TORRENT PHARMACEUTICALS LTD. (APPEAL FROM ORDER NO 275 OF 1996) decided by this Court (Coram : N. N. Mathur, J.) on 11th June, 1996. The marks which were for consideration of the Court were ALPRAX and ALREX and this Court refused to interfere with the interim injunction granted by the trial Court on the ground that there was apparent similarity between two marks which would have caused confusion in the mind of unwary purchasers.

Mr. Kadam, learned counsel also placed reliance upon the passage of Whitford, J. in the matter of Stuart Pharmaceuticals Limited v. Rona Laboratories Ltd. reported in FSR [1981] at page 20. The marks which were for consideration were 'SORBISLO' and 'SORBITRATE'. Following observations appearing at para 22 were pressed into service :

"It is I think on the evidence quite plain that at the moment what I think are described as over the counter-sales are relatively rare but they do take place and that is a factor which I must bear in mind for it may not always be easy to know when over the counter sales may not increase. At any rate the bulk of the sales at the moment are sales on prescription. So that what has to be considered is whether the use of these names is likely to cause confusion among doctors writing prescriptions, among dispensers dispensing prescriptions, and to some extent, among the public who might, though in a very small number of cases as things are going at present, make purchases over the counter. So far as the dispensed product is concerned, once it is in the hands of the member of the public who is taking the drug, all opportunity for confusion has passed, if he has obtained it on the prescription."

The Court was dealing with the registered trademark of the plaintiff 'Sorbitrate' against the proposed newly introduced trade mark of the defendant namely ' Sorbisol'. In the back ground of the facts set out at length, it was found that there was prima-facie case for the plaintiffs whose trade mark was registered long back to succeed in the suit so as to make available for the plaintiffs interlocutory injunction.

Mr. Kadam, learned counsel for the appellant, by way of summarising the submissions, referred to the Division Bench Judgment of the Bombay High Court in the case of M/s. Hiralal Parbhudas v. M/s. Ganesh Trading Co. and others reported in AIR 1984 Bombay 218 where the Bench summarized the propositions regarding the question of deceptive similarity between two marks in paragraph-5 as under :

"In deciding the question of similarity of two

marks, the following well established principles are to be observed:- (i) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (ii) overall similarity is the touchstone, (iii) marks must be looked at from the first impression of a person of average intelligence and imperfect recollection, (iv) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (v) marks must be compared as a whole microscopic examination being impermissible, and (vi) the broad and salient features must be considered for which the marks must not be placed side by side to find out difference in design. In addition, the nature of the commodity, the idea of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration."

The Bench was considering the marks on the respective labels "Himatlal Special Bidi" and "Hiralal Chhap Bidi" and had found that the labels were deceptively similar.

However, soon after the aforesaid decision, same Bench, in the case of *M/s. Johann A. Wulff v. Chemical Ind. & Pharmaceutical Laboratories* and another reported in AIR 1984 Bombay 281, added the following proposition:

"The Court is not concerned with hypothetical possibilities but with the ordinary practical business probabilities having regard to the circumstances of the case."

In that case, the Bench was required to consider the marks 'CIPLAMINA' & 'COMPLAMINA' and the Bench found that there was no deceptive similarity between two marks.

In reply, learned counsel appearing for the respondent firstly submitted that there is a marked difference between a passing of action simpliciter and the action arising from the alleged infringement of a registered trade mark. For that purpose, he relied upon a decision of the Apex Court in the case of *Kaviraj Pandit Durga Dutt Sharma versus Navaratna Pharmaceutical Laboratories* reported in AIR 1965 SC 980. It has been

observed :

"An action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another. But, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the 'exclusive right to the use of the trade mark in relation to those goods. The use by the defendant of the trademark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colorable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colorable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trademark of the plaintiffs have been adopted by the defendant, the fact that the get up, packing and other writing or marks on the goods or on the packets in which he offers his goods, for sale show marked differences or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial whereas in the case of passing off, the defendants may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

However, it has to be borne in mind that the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions. See also *Ruston and Hornby Ltd. v.*

Mr. Shelat, therefore, submitted that this matter has to be viewed from the aforesaid basic difference between the nature of two actions and as observed by the apex court in the aforesaid decision, distinguishing features of the marks vis-a-vis the products in question would have great deal of relevance while deciding whether any confusion is likely to be caused as a result of the use of the mark in question.

Mr. Shelat then made a reference to the decision of this Court in the matter of CIBA GEIGY LTD. V. M/S. SUN PHARMACEUTICAL INDUSTRIES [33 (2) GLR 153]. In that case, the products were Schedule "H" Drugs and they would be available only on the prescription of a registered medical practitioner. Thus, bearing in mind the nature of product, this Court observed that the availability of the product on prescription of the Registered Medical Practitioner would be a relevant consideration for the purpose of deciding question of dissimilarity between two marks. It has been observed that there is no test which can universally be applied to all the cases and that the test may vary from case to case depending upon the class of purchasers, class of dealers, or sellers, availability of such commodity in the open market and so on and so forth. Illustrating this proposition, this Court said that the purchase of biscuit can neither be compared with purchase of a machine nor with a medicine. This Court observed that even in the case of medicine, the question may be posed before the Court in a given case whether such a medicine would be available freely in the market or can be had only upon prescription of a Doctor. Following observations appearing in paragraph 22 to 25 were highlighted by the learned counsel for the respondent and, therefore, they need be reproduced here:

"22. A leading case, in my opinion, is an English decision in the case of *Re Bayer Products Ltd.*, reported in 1947 (2) All ELR 188. The question before the Court of Appeal was whether two marks DIASIL and ALASIL could be said to be deceptively similar, Lord Greene M.R. considered the fact that the legislature ensured that the Scheduled poisons shall only be dealt with by skilled and responsible persons, subject

to very careful regulation. 'It is obvious that, once you get a statutory regulation of the channels of supply, it is essential that the Court, in considering the possibilities of deception, should take into account the extent to which such a possibility is minimized, or, perhaps, obliterated altogether by the statutory regulations.

23. The learned Master of the Rolls then observed: 'Once you get the position that only a doctor can order sulphadiazine, that he must give a written prescription, and that a chemist cannot supply it without such a prescription, you ensure that the article is only going to pass at that stage through the hands of skilled persons, who by their training, their experience and their knowledge would be most unlikely to refer to it in a way which would admit of any reasonable possibility of confusion.

24. It was also argued that in spite of such regulations the possibility of confusion could not be ruled out altogether. Dealing with such a situation, the Court observed:

'It is impossible of course, to exclude entirely the risk of confusion. What we are concerned with are, not unlikely cases which may happen once in one hundred years but reasonable probabilities, and we have to ask ourselves in relation to those facts. Is there such a risk that a doctor or a chemist, or the two of them in combination, by some carelessness in expression, some obscurity in handwriting, some slip of recollection, or some careless mistake which you would not expect highly trained professional people to fall in to, will refer to the product in such a way as will lead the Court to say that there is a reasonable probability of confusion. In my opinion, there is not. It seems to me that, if one is really to give weight to such a risk, it involves attributing to those highly skilled, experienced, and careful people, to whom- and to whom alone- the legislature has entrusted the precautions necessary under the Pharmacy and Poisons Acts, qualities of carelessness or incompetence which are not usually found in that class of persons. We are concerned not with hypothetical possibilities, but with the ordinary practical business

probabilities having regard to the circumstances of the case. (emphasis supplied)."

25. In my judgment, inclusion of a drug in Schedule 'H' to the Drugs and Cosmetics Rules, 1945 and its availability only on the prescription by a Doctor is indeed a fact which cannot be ignored by a Court of Law. There is, therefore, really remotest possibility of mistake or confusion. The Court will certainly consider reasonable probabilities of any confusion or mistake but at the same time, cannot base its decision on remotest or hypothetical possibilities. In my opinion, the argument of Mr. Vakil is well founded that an ordinary lay-man when he would be purchasing medicine of such a nature, he would be on his guard and quite cautious and would not allow himself to be satisfied with a different medicinal preparation. Similarly, under the Rules a duty is cast on the doctors and they cannot consistently with that duty pass on any other preparation instead of the one prescribed by the Doctor. By doing so, they would be committing breach of the provisions of the Rules as also conditions of licence. Mr. Desai, no doubt, submitted that this aspect cannot be considered by the Court at this stage while deciding application Exh. 5. I am unable to accept the said submission. In my judgment, all relevant material and facts which can be considered at the time of hearing of the suit can be considered at the time of hearing of application Exh. 5 also. I, however, make it clear that all the observations made by me hereinabove must be treated as prima-facie observations only to the extent to deciding application Exh. 5 and the trial Court while deciding the suit will not be influenced by those observations and will decide the matter in accordance with law on merits."

The aforesaid matter went before the Hon'ble Supreme Court. While rejecting the Special Leave Petition in the case of Ciba Geigy, [1997 PTC(17) pg. 364], the Court observed that if "damages" as the measure recoverable at common law would be adequate remedy and the defendant would be in a financial position to pay them, no interlocutory injunction should normally be granted, however strong the plaintiff's claim appeared to be at that stage.

Reference has then been made to the decision of this Court in the matter of Thakkar Balvantrai Purshottamdas v. Hasmukhbhai Ugarchand Patel reported in 35(2) GLR 1714, for the proposition that in a passing off action, where there is appreciable difference between the two marks, interim injunction restraining the defendant from selling his goods cannot be had by the plaintiff.

Reference has also been made to the decision of Delhi High Court in the matter of Biofarma and another versus Sanjay Medical Store and others reported in 1997 (1) Arb. L.R.558. The two marks namely, 'trivedon' and "flavedon" were found to be prima facie dissimilar to each other. The factor that the medicine is available on doctor's prescription only and not across the counter was held to be a relevant factor to be taken note of while deciding whether the two words are deceptively similar to each other or not. The Court has held that the fact that the two pharmaceutical products, one each of the plaintiff and the defendant, are to be sold at different prices itself ensures that there is no possibility of any deception/confusion being caused, particularly in view of the fact that a customer, who approaches a chemist with the intention of purchasing the product of the plaintiff, will never settle down for a drug of the defendant which is priced lower and the difference is visible at that stage itself.

Reference has then been made to another decision of the Delhi High Court in the matter of M/s. Panacea Biotec Ltd. Versus M/s.Recon Ltd., reported in 1996 PTC (16) at page 561 in which case, the disputed marks were "NIMULID" and 'REMULIDE". The stress in this case was with regard to the founding mark being descriptive of composition of the medicine. Following observations in para 10 of the citation would assume importance in so far as the present case is concerned:

" Having regard to the aforesaid decisions, I am of the opinion that where a party uses a descriptive and generic term for its trade mark it cannot be given sole right to use the same to the exclusion of the other traders. Commonly used words in trade and descriptive of the nature or colour or laudatory of the quality of the goods cannot be permitted to be monopolised Similarly, in the case of a medicine, if a

manufacturer uses the name of the basic drug of which it is constituted, no monopoly can be claimed by him in regard to the use of the same as his trade mark. "

It was, therefore, submitted that the two marks using common word 'FALCI' indicative of description of the disease which is commonly known amongst the people by its word namely FALCIPHARUM will have to be compared and read alongwith the other letters used in the word. Use of the word "FALCI" as prefix to both the marks cannot bring any similarity which would result into confusion in the minds of unwary consumers who would obviously be looking at trade mark with particular reference to the letters suffixed. Thus viewed, both the marks in question cannot be said to be similar in nature.

Then there is a reference to the decision of the Delhi High Court in the case of S.B.L. Limited versus Himalaya Drug Co. reported in AIR 1998 DELHI 126. That was a case of disputed mark 'LIV.52' ABD 'LIV.T' The Court observed that "Liv" had become general term of publici juris and that it was descriptive in nature and common in usage. The result would be that the customer would tend to ignore the common feature and will pay more attention to uncommon feature namely '52' and 'T'. Following observations appearing in paragraph 25(3) would assume importance :

"Nobody can claim exclusive right to use any word, abbreviation or acronym which has become public juris. In the trade of drugs it is common practice to name a drug by the name of organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being publici juris or generic cannot be owned by any one for use as trademark. "

The submissions noted above have been further sought to be fortified by the aforesaid decision rendered by Delhi High Court referring to the use of 'ailment' or 'disease' as part of the mark in question. Reference has also been made to ER Squibb & Sons Inc. v. Curwel India Ltd. reported in AIR 1987 Delhi 197 for canvassing one of the aforesaid submissions that the medicinal preparations falling under Schedule 'H' of Drugs and

Cosmetic Rules 1945 which could not be sold without doctor's prescription and without following the safeguards would be one of the relevant considerations for dealing with the matter in respect of the disputed marks concerning the medicines falling under Schedule 'H' of drugs and Cosmetics Rules, 1945.

It has lastly been submitted on behalf of the respondents that even prior to the plaintiffs, Alembic Chemical Works Company Limited had applied for registration of its product 'FALCIGO'. That happened on 19th July, 1996. The plaintiff went for registration of its product 'FALCIGO' on or around 20th August, 1996. In reply Mr. R. R. Shah, learned advocate appearing on behalf of the respondent submitted that although application for registration of the mark of Alembic Works is prior to the application of the plaintiff, production and marketing of the product of the plaintiff has already commenced prior to that of Alembic Chemical Works Company Ltd. In my opinion, this new submission will not have any consequence for the present on the merits of the interim proceeding in as much as the use of the word "FALCI" is attributable to the ailment which has become quite common in the mind of the public.

CONCLUSION

Coming to the facts of the present case, it might be noted that the learned trial Judge has referred to the respective marks FALCIGO and FALCITAB in his impugned order and has found on prima facie consideration of the facts that they are neither deceptively similar nor would result in any confusion in the mind of the users of the products. He has then proceeded to consider the distinguishing features with regard to both the products being required to be used by the hospitals, medical institutions and clinics only. He has proceeded to consider the distinctive features of the strips containing tablets used for the respective products. He has noted the difference in the price of the products in question as stated above. He has referred to the source of drug being different in both the products. He has also noted the difference arising from the caution note and the side effects set out by the defendant Co. for the use of its product namely FALCITAB. He has therefore come to the conclusion that both the marks are distinguishable in their formulation, price, strip appearance, descriptive names and phonetic impressions. All the aforesaid distinct features are relevant considerations and the submissions made by the learned

counsel for the appellant contrary to the same cannot be accepted. Learned counsel for the appellant proposed to highlight the contra-indications, warnings and adverse reactions printed on the literature of the FALCITAB. However, while dealing with the said instructions, one has not to forget that the product FALCITAB is a medicine meant for the treatment of deadly disease FALCIPHRUM. Simply because there are certain contra-indications and warnings and precautions for the use of the medicine by the medical experts, it cannot be said that the medicinal value of the product is not to be looked at. Even with regard to the product FALCIGO, there are certain adverse reactions and precautions which have been frankly presented by the learned counsel for the appellant and which were not available before the trial Court. Therefore, the administration of the rival medicines requiring prescription by a doctor and requiring use in the hospitals or medical institutions or clinics will have to be viewed from the stand point of the restrictive user thereof in the treatment of FALCIPHARUM MALARIA. Both the products have following conditions for permission to manufacture the products :

"The lable carton, package insert or any other promotional literature on the product shall bear the wording 'FOR HOSPITAL USE ONLY' in an indelible ink in a box at a prominent place."

"The preparation shall be exclusively meant for supply to hospitals/institutions/nursing homes and is prohibited to be sold, stocked and distributed through retail outlets."

I have also verified the cartons and packings of the respective products and the conclusion of the trial court that they are visually different from each other has to be accepted. Thus, it cannot be said that there is a likelihood of confusion being caused to an unwary consumer in respect of the disputed marks.

In above view of the matter and bearing in mind the facts concerning the marks in question, there is little chance of any passing off of one product for the other product.

In the result, this appeal fails and the same is

hereby dismissed with no order as to cost. As the appeal is disposed of as dismissed, Civil Application No.5735 of 1998 also stands disposed of with no order as to cost.

Vyas